

REMARKS/ ARGUMENTS

The foregoing amendment and the following arguments are provided to impart precision to the claims, by more particularly pointing out the invention, rather than to avoid prior art.

35 U.S.C. § 103(a) Rejections

Examiner rejected claims 1, 2, 7, and 8 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,429,387 B1 (hereinafter “Kuribayashi”) in view of U.S. patent 4,471,408 (hereinafter “Martinez”).

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). (Manual of Patent Examining Procedure (MPEP) ¶ 2143.03).

Applicant’s independent claims include limitations that are not disclosed nor suggested by Martinez nor Kuribayashi. Therefore, Applicant’s independent claims are patentable over Martinez and Kuribayashi.

More specifically, the outstanding office action states that Martinez discloses an integrated circuit in which pins are selectively bent or broken to encode information. A careful reading of Martinez reveals, however, that the pins selectively bent or broken in Martinez are not the pins of the integrated circuit package but rather the pins of a separate piggyback device that is clipped to the top of the package.

Kuribayashi discloses a BGA package including solder balls formed directly on the underside of the integrated circuit package. Applicant respectfully submits, therefore, that Kuribayashi may not be combined with Martinez in the manner suggested in the recent office action, because there would have been no reasonable expectation of successfully modifying Martinez and Kuribayashi at the time Martinez or Kuribayashi was invented. (See Manual of Patent Examining Procedure ¶ 2143.02; See also *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976), and *Ex parte Erlich*, 3 USPQ2d 1011 (Bd. Pat. App. & Inter. 1986).

In particular, neither Kuribayashi nor Martinez disclose or suggest how one skilled in the art would attach the piggyback device of Martinez to the surface of the BGA package of Kuribayashi with any reasonable expectation of making a connection to the solder balls on the underside of the BGA package. One skilled in the art would further recognize that such a piggyback device, if extended to the underside of the BGA package, would likely interfere with the electrical coupling between the BGA device and the substrate.

Furthermore, the mere fact that a reference can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the modification or combination. *In re Mills*, 916 F.2d 80, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claim, there must be a suggestion or motivation in the reference to do so. *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990). (See also MPEP 2143.01). In the present matter, neither Martinez nor Kuribayashi actually suggest modifying nor

combining the references to provide applicant's claimed limitations as set forth in applicant's independent claims.

Therefore, in view of the distinctions and remarks set forth above, applicant respectfully submits that the combination of Martinez and Kurabayashi do not teach or suggest the limitations claimed by applicant, and applicant's independent claims are patentable over Martinez and Kurabayashi. In addition, applicant's remaining claims depend from at least one of applicant's independent claims and therefore include the distinguishing claim limitation of applicant's independent claims, and are therefore also patentable over Martinez and Kurabayashi.

CONCLUSION

Applicants respectfully submit the present application is in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call John Ward at (408) 720-8300, x237.

Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN



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Date: 07/07/2003

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Appl. No. 09/470,092  
Amdt. dated 07/07/2003  
Reply to Office action of May 7, 2003